

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RONALD P. SANSONE, FRAN E. BLACKMAN, DANIEL F. DLUGOS,  
LEON A. PINTSOV, DENIS J. STEMMLE and FRANCIS X. HINES

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Appeal No. 2002-2193  
Application 09/316,795

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ON BRIEF

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**MAILED**

**OCT 27 2003**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Before OWENS, WALTZ, and LIEBERMAN, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*< DECISION ON APPEAL >*

This appeal is from the final rejection of claims 1 and 6-22, which are all of the claims remaining in the application.

*THE INVENTION*

The appellants claim a method for direct delivery to a recipient by a post office of mail that is addressed to the recipient at a virtual post office box. Claim 1 is illustrative:

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1. A method for forwarding mail by a post that is addressed to a recipient at a virtual post office box to be delivered directly to a recipient, said method comprises the steps of:

receiving recipient's name and recipient's desired delivery address;

assigning a virtual post office box for individual recipients;

relating recipient's virtual post office box with the desired delivery address of the recipients;

delivering to recipients their assigned virtual post office box's identification;

placing virtual post office boxes on mail;

reading mail to capture virtual post office box identification, when present;

determining recipient's desired delivery address from virtual post office box identification and recipient's name;

verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address;

placing recipient's desired delivery address on mail in coded form and human readable form; and

delivering mail to the desired delivery address of the recipients.

#### *THE REFERENCES*

Allum et al. (Allum)	5,420,403	May 30, 1995
Allen et al. (Allen)	5,422,821	Jun. 6, 1995
Boies et al. (Boies)	6,006,200	Dec. 21, 1999
		(filed May 22, 1998)

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### *THE REJECTIONS*

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1 and 6-21 over Boies in view of Allum, and claim 22 over Boies in view of Allum and Allen.

### *OPINION*

We reverse the aforementioned rejections and remand the application to the examiner. We need to address only the sole independent claim, i.e., claim 1.

The appellants' claim 1 requires the step of "verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address". For a disclosure of this limitation the examiner relies upon the step in Boies' claim 1 of "accessing the master file database by a shipper to obtain the customer's shipping address" (col. 4, lines 5-6) (answer, pages 4 and 8-9).

In Boies' accessing step there is no verification that the recipient's name is listed with the recipient's desired delivery address in a database. Boies merely obtains the customer's shipping address that corresponds to the customer's multi-digit identifier. As argued by the examiner (answer, page 8), that shipping address may include the customer's name. However, Boies does not verify that the name in that address is the recipient's

name. Hence, in Boies' method if the shipper is given the wrong multi-digit identifier, the accessing step will not obtain the correct customer's name/shipping address and, if the wrong multi-digit identifier corresponds to another customer's name/shipping address, the error will not be detected. The appellants' method includes a step for detecting that error by verifying that the recipient's name is the name which is listed in the database with the customer's address.

The examiner does not rely upon Allum or Allen for a disclosure which remedies the above-discussed deficiency in Boies.

For the above reasons we conclude that the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the appellants' claimed invention.

*REMAND*

The step of "verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address" was added to the appellants' claim 1 by amendment (filed August 13, 2001, paper no. 5, page 19). In that amendment the appellants did not point out where written descriptive support for that step appears in the original disclosure.

The appellants' original disclosure includes a statement

that "[v]irtual post office box data center 75 contains a virtual post office name/address relational data base 68 (Fig. 4)"

(page 7, lines 8-9). The discussion following that statement, however, merely discloses correlating the virtual post office box number with the address. That discussion, therefore, indicates that "relational" in "name/address relational data base 68" refers to the relation between the virtual post office box number and the name/address rather than the relation between the name and the address. Clearly, there is no discussion of verifying in one or more databases that the recipient's name is listed with the recipient's desired delivery address.

We therefore remand the application for the examiner and the appellants to address on the record whether the appellants' original disclosure provides adequate written descriptive support for the step in claim 1 of "verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address". If the examiner does not find adequate written descriptive support for that step, the examiner should reject the appellants' claims under 35 U.S.C. § 112, first paragraph, written description requirement.

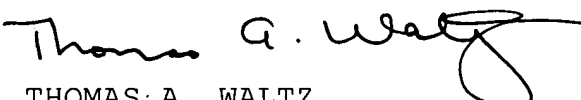
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*DECISION*

The rejections under 35 U.S.C. § 103 of claims 1 and 6-21 over Boies in view of Allum, and claim 22 over Boies in view of Allum and Allen, are reversed. The application is remanded to the examiner.

*REVERSED and REMANDED*

  
TERRY J. OWENS  
Administrative Patent Judge )  
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)

  
THOMAS A. WALTZ  
Administrative Patent Judge ) BOARD OF PATENT  
)  
) APPEALS AND

  
PAUL LIEBERMAN  
Administrative Patent Judge ) INTERFERENCES  
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